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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,443	03/24/2000	Jeffrey L. Johanning	ADV-B-291	3408
7590 11/03/2003			EXAMINER	
DUANE MORRIS LLP 1667 K STREET NW SUITE 700 WASHINGTON, DC 20006			PATEL, ASHOK	
			ART UNIT	PAPER NUMBER
			2879	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,443

Applicant(s)

JOHANNING, JEFFREY L.

Examiner

Ashok Patel

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-80 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. In view of reconsideration of previously issued restriction requirement, the Examiner issues a fresh Restriction requirement required under 35 U.S.C. 121 as follows:

- I. Claims 1-30 and 73-78, drawn to an HID, classified in class 313, subclass 25.
- II. Claims 31-69, 71 and 72, drawn to a structure, classified in class 313, subclass 238.
- III. Claim 70, drawn to a getter cap, classified in class 417, subclass 48.
- IV. Claims 79-80, drawn to a method of positioning an arc tube within an HID lamp, classified in class 445, subclass 25.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the HID (as

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recited in claims 1-20) does not require specific mounting structure as recited in claim 32 or 45 or 60 or 71. The subcombination has separate utility such as a CRT, an incandescent lamp, a vacuum tube etc..

Inventions "I and III" or "II and III" or "IV and III" are unrelated/diversified.

Inventions IV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, it is not required to follow method steps as specifically claimed in claims 79-80 to obtain the HID lamp of claims 1-30 and 73-78.

3. If applicant elects Group II (a structure), then following election of species applies:

Species I: a structure including no weld between a frame and a stem assembly, claim 31;

Species II: a structure including an elongated frame, a stem assembly (having a stem and a stem clamp), claims 32-40;

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Species III: a structure including no weld between a frame and at least one of spaced apart clips, claims 41-44;

Species IV: a structure including an elongated frame (having one or more swaged portions, a slot) and an arc tube clip, claims 45-54;

Species V: a structure including no weld between a frame and at least one of shroud caps, claims 55-59;

Species VI: a structure including a frame (having legs, swaged portions) and a shroud cap (having spaced apart frame retaining tabs, slots), claims 60-69;

Species VII: a structure including a frame and a stem assembly (having a stem and a heat shield), claims 71-72.

The Examiner identified distinct species in terms of Grouping of claims instead of disclosed drawing Figures. The Examiner requires applicant to elect, under 35 U.S.C. § 121, the single disclosed species for prosecution on the merits based on the grouping of claims, as per M.P.E.P. section 809.02(a). Depending upon applicant's persuasive arguments (in the next response), the Examiner would modify the above-mentioned election of species to include more claims into elected species.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

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their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III or IV, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Mr. Duane Morris on October 27, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 703-305-4934. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be

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reached on 703-305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.


Ashok Patel
Primary Examiner
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